

## **REMARKS/ARGUMENTS**

### ***Status of the claims***

Claims 1, 9, 10, 13, 14, 16 – 21, 24, 25, 29, and 30 are pending in the application. Claims 1, 9, 10, 13, 14, 18, 21, 24, 25, 29, and 30 have been amended to comply with the Examiner's prior objections and to overcome the Examiner's prior rejections. Claims 4 – 8, 11, 12, 15, 22, 23, 26 – 28, and 31 have been cancelled.

### ***Introduction***

In Examiner's September 08, 2005 Office Action, the Examiner: rejected claim 31 as lacking enablement and sufficient written description as per 35 U.S.C. 112 (*see OA at 5*); rejected claims 1, 4-12, 14, 15, 21-26, and 28-29 as being anticipated by Klatt et al., U.S. Patent No. 6,473,760, entitled "Apparatus for Printing Information Automatically Combined from Two Different Sources" under 35 U.S.C. 102(e) (*see OA at 11*); rejected claim 27 as being obvious in light of Klatt et al. in view of ImageX.com *SEC Filing* of 12 May 1999 under 35 U.S.C. 103(a) (*see OA at 20*); and rejected claims 13, 16-20, and 30-31 as being obvious in light of Klatt et al. and Official Notice (*see OA at 21*). Klatt et al. was filed on January 10, 2000. It purports to be a continuation of 09/460,307, filed on December 13, 1999.

### ***Objections to claim language as indefinite***

Examiner objected to the words 'predeterminable profile,' 'directly,' 'or,' 'automatically,' 'developing a list of fields,' 'enable,' and 'predefined' as indefinite. The words

in this list are not remotely indefinite. Anyone skilled in the computer arts would understand the meaning of these words. This is shown by the Examiner's own definitions of these terms.

***Objection that Claims 14 and 15 do not further limit Claim 1***

Examiner objected to claims 14 and 15 in that they do not further limit claim 1. Applicant has cancelled claim 15, but traverses Examiner's conclusion regarding claim 14. Claim 14 limits claim 1 by requiring use of the step of the merging of data collected according to the field lists. Applicant respectfully urges Examiner to admit claims 14 based upon these recited distinctions.

***Objections to language of Claim 18***

Examiner objected to the language 'said template step' as having no previous reference. The language of claim 18 has been amended to refer to claim 1 by including the language 'the generating of a company-tailored prototypical product step.'

***Rejection of Claim 31 under §112, ¶1***

Examiner rejected claim 31 as failing to comply with the enablement and written description requirement of 35 U.S.C. 112, ¶1. Applicant has incorporated the limitations of Claim 31 into Claim 30 and has eliminated the word 'simultaneous' in the amended Claim 30 to overcome this rejection.

***Objections to Affidavits under 37 CFR 1.131***

In the September 08, 2005 Office Action, the Examiner found the affidavits of Leonard H. Lopez Jr. and Norma Rodriguez filed on 24 May 2005 under 37 CFR 1.131 to be ineffective

to overcome the Klatt reference and/or the SEC filing of 12 May 1999. OA, at 7. Examiner found that the presented affidavits were insufficient to establish diligence, conception, or actual reduction to practice to establish a date of priority over Klatt. Examiner also objected to the affidavits because of a purported lack of “[o]riginal exhibits of drawings or records” or copies thereof as required by 37 CFR 1.131(b).

To overcome Examiner’s objections to the sufficiency of the prior submitted affidavits, Applicant is respectfully submitting that Examiner’s evaluation of the proffered evidence and affidavit’s is incorrect. Applicant offers again that which has already been offered: the affidavits of Leonard H. Lopez, Jr. and Norma Rodriguez, and Exhibits A – J, for reconsideration. To establish an actual reduction to practice requires a showing that the process actually worked for its intended purpose. Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1578 (Fed. Cir. 1996). The inventor must show independent corroborating evidence in addition to his or her own documents, such as testimony of a witness other than the inventor or evidence of surrounding facts and circumstances independent of information received from the inventor. Markman v. Lehman, 987 F. Supp. 25, 30 (D.D.C. 1997).

Under these guidelines, Applicant is requesting that the Examiner reconsider the affidavit from Norma Rodriguez, a procurement agent of a client, KCI, of the Applicant’s company. This client attests that the documents attached as Exhibits to the aforementioned 1.131 affidavit result from a series of transactions that occurred during the months of June through October of 1999. This affidavit further asserts that during this timeframe, the attestee’s company made use of the Applicant’s invention to provide printed business cards.

A more thorough analysis of the previously provided exhibits, specifically Exhibits C, D, G, and I demonstrate actual reduction to practice at a date before that of the Klatt prior art.

Applicant does not understand the need to show diligence or conception, as requested by the Examiner at OA page 7, because a demonstration of actual reduction to practice is sufficient to antedate the claimed priority date of Klatt, thus removing it as prior art.

Previously presented Exhibits C, D, G, and I together demonstrate actual reduction to practice. All of the exhibits are from the online Stationery Ordering System as evidenced by the titles, the uniform resource locators (URLs), and dates at the bottom of each exhibit. Examiner argues that Exhibit D is insufficient because it “fails to show that the [list of stationery products] can be acted upon” because there is no hyperlink to allow purchase of the listed stationery products as posited. However, this is incorrect because, although the list of stationery products is not hyperlinked, it is clear that the listed products are available with “just clicks of your mouse,” (*see* Exhibit D) through answering the question posed: “Have you used this system before? YES NO.” (*see* Exhibit D). So, there is a way in which to act upon ordering the specified products.

The actual reduction of practice is further evidenced by Exhibit C. Examiner explains that Exhibit C is merely a static page that does not show “inputting a predetermined profile … as described in [disclosures],” or display the process of collecting and providing company-indicative informational elements and content, or the process of generating a customized company-tailored prototypical product record, or the process of selecting and ordering a company-tailored prototypical produce record to be printed according to the record and contents. OA at 10. Applicant understands that Exhibit C is a static representation of the page, but it is merely a representation of a conduit for information and becomes dynamic once the user begins to enter information. How does one show “inputting a predetermined profile” without submitting a video? The word ‘inputting’ necessarily implies a change through time. The easiest and most efficient method to show such a change, as is needed here, is to provide the means by

which that change in time occurs; hence, Applicant provides Exhibit C. Exhibit C is a representation of the means by which a new user creates a predetermined profile for use in printing on the stationery items as shown in Exhibit D. Applicant would also like to direct Examiner's attention to the URL at the bottom of Exhibit C such that it ends with '.asp'. ASPs, or active server pages, are by definition dynamic.<sup>1</sup> So, that further evidences use of the disclosed invention because it indicates that the pages are being generated by using user-specific data to generate each webpage such that they can be company-tailored.

Exhibits G and I are similar in that they are billing statements as produced by the online Stationery Ordering System, but each has its independent significance. Examiner states that Exhibit G fails show that the business cards and invoice were created by the invention. OA at 11. However, Applicant respectfully disagrees. It is difficult for one exhibit to show everything that demonstrates the entire process of ordering online stationery, but the exhibits taken together demonstrate that the online Stationery Ordering System was indeed running before the earliest date claimed by Klatt, December 13, 1999. Exhibit G is indicative of the billing screen associated with the online Stationery Ordering System. Applicant directs Examiners attention to the hyperlinks below the billing statement box that would return the user to the 'Processor Main' and 'Billing Statements' webpages. Also, the web address and date at the bottom of the exhibit indicate that it was used online and at a date before the Klatt priority date.

Exhibit I is important because it shows different users ordering different stationery products with different user names all through the online Stationery Ordering System before the Klatt priority date. Applicant notices that Examiner did not comment upon Exhibit I. Applicant directs Examiner's attention to the following facts: order #936 was for Desk Nameplates; order

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<sup>1</sup> [http://www.webopedia.com/TERM/A/Active\\_Server\\_Pages.html](http://www.webopedia.com/TERM/A/Active_Server_Pages.html)

#956 was for Business Cards; order #964 was for notepads; order #969 was for name badges; order #977 was for envelopes; and order #1053 was for letterhead. Exhibit I indicates specific orders on specific dates before the application for Klatt with individual users and prices, and most importantly, specific products. Exhibit I shows that each of the stationery products listed in Exhibit D were available to be and indeed were actually acted upon through the online Stationery Ordering System.

Applicant respectfully submits that Examiner is incorrect in arguing that the supporting affidavits lack exhibits of drawings or records because of the submission of the above identified exhibits. The provided exhibits are records under 37 CFR 1.131 and are sufficient to show actual reduction to practice before the priority date of Klatt.

Based on these newly submitted arguments, Applicant respectfully requests that Examiner accept the declarations as sufficient under 37 CFR 1.131.

### ***Objections to claims under 35 U.S.C. 102***

Examiner rejects claims 1, 4-12, 14-15, 21-26, and 28-29 as being anticipated by Klatt, U.S. Patent No. 6,473,760, entitled "Apparatus for Printing Information Automatically Combined from Two Different Sources" under 35 U.S.C. 102(e). Applicant respectfully submits that the affidavits of the Lopez and Rodriguez prove, with the above listed exhibits, that Applicant successfully and actually reduced the claimed invention to practice before the priority date in Klatt; and by such evidence, Applicant has removed the need for rejecting to the claiming of this invention.

Alternatively, Applicant has amended independent Claim 1 to incorporate the cancelled claims 4 through 8. Applicant has also amended independent Claim 21 to incorporate the

cancelled claims 22 and 23 and has amended independent Claim 25 to incorporate the cancelled claims 26 through 28.

With these changes, Applicant respectfully submits that the current claimed invention is merely a species of the genus disclosed by Klatt. A species may anticipate a genus, but no genus can anticipate a species. *Chester v. Miller*, 906 F.2d 1574, 15 U.S.P.Q.2d 1333 (Fed. Cir. 1990). Thus, Applicant argues that the current application should be granted over the Klatt prior art as being a species of the Klatt disclosed genus.

***Rejection of Claim 27 under 35 U.S.C. 103***

Applicant has incorporated the limitations of cancelled Claim 27 into the currently amended Claim 25. Examiner had rejected claim 27 as being obvious in light of Klatt, U.S. Patent No. 6,473,760, in view of ImageX.com SEC Filing of 12 May 1999. Examiner cites the following from the ImageX.com SEC Filing:

ENHANCES CONTROL AND SCALABILITY: From the password-protected Online Printing Center, authorized customer employees can individually modify, proof, procure and manage a wide variety of printed business materials within the centralized parameters and preset rules established by the customer.

Applicant respectfully submits that the arguments presented above in regard to the Lopez and Rodriguez affidavits and proffered exhibits overcome the Klatt patent as prior art.

In the alternative, in the application of 35 U.S.C. 103, the following must be adhered to:

- (1) The claimed invention must be considered as a whole; (2) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (3) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (4) Reasonable expectation of success is the

standard with which obviousness is determined." *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). Applicant respectfully submits that Examiner has failed to follow these basic tenets. The claimed invention and references must each be considered as a whole with also the motivation to make the combination; however, the vague ImageX.com SEC Filing lacks sufficient disclosure as to what it does and provides no motivation to combine the references such that would render the claimed invention obvious. Examiner argues that Klatt does not teach Claim 27, but that the SEC Filing does, and suggests motivation. OA at 20-1. Applicant argues that Examiner is impermissibly viewing the claimed invention and motivation to combine the claimed references with the benefits of hindsight. It may seem obvious now to one skilled in the art to combine the references, but at the time it is far less likely.

***Rejection of Claims 13, 16-20, 30, and 31 under 35 U.S.C. 103***

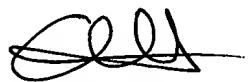
Examiner also rejected claims 13, 16-20, 30, and 31 as being unpatentable over Klatt, U.S. Patent No. 6,437,760, in view of Official Notice. With respect to claims these claims, Applicant submits that the claimed prior art from Official Notice had been sufficiently traversed and could not possibly become prior art. It is necessary to adequately define the art to which the currently claimed invention belongs. One skilled in the art of printing would not have known server-side scripting such as Active Server Pages or HTML programming or scripting on the internet. As the art developed, the need for such knowledge also developed. Hence, the online print request services developed. But, at the time of invention, such knowledge was not within the scope of information one skilled in the relevant art would know. The examiner is simply trying to invent prior art where it does not exist. There was no motivation provided by either Klatt or the Official Notice prior art to combine the two such that would render the currently

claimed invention obvious. None of the prior art listed demonstrates independent or collective motivation to combine such art with that of Klatt. For example, one skilled in the art of printing would not have been knowledgeable enough to understand scripting environments such that they would combine such art with Klatt.

***Conclusion***

In view of the foregoing arguments, Applicants respectfully ask that all rejections be withdrawn. Believing that all things raised in the Examiner's September 8, 2005 office action have been addressed, the undersigned respectfully requests that the application be allowed and passed to issue.

Respectfully,



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